

## REMARKS

Claims 1-31 are currently pending. Though Applicant does not amend any of the claims with this Response, Applicant respectfully provides a Listing of the claims for the Examiner's convenience.

### Claim Rejections Under 35 U.S.C. §102(b)

Claims 18-20 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kelly et al. U.S. Patent No. 6,006,482 hereinafter referred to as "Kelly."

Applicant's claim 18 recites *inter alia*:

"a secondary waterproof membrane *loose laid* over said energy absorbing layer."

Kelly does not teach a secondary waterproof membrane *loose laid* over said energy absorbing layer. Instead, referring to column 9 lines 24-26, Kelly teaches that a screw 20 is "mounted in termination bar 18 and driven through all of the layers of the existing roof deck to secure the entire assembly." As is clearly shown in Figure 31 of Kelly, the screw 20 is disposed through the membrane 9 and into the layers below so as to mechanically secure the membrane 9 to the layers below the membrane 9. Thus, Kelly teaches a mechanical securing of membrane 9 to the layers below membrane 9 as opposed to the *loose laid* membrane recited in Applicant's claim 18. Applicant respectfully notes that a loose laying of the membrane is important to hail resistance in that a taught membrane is more likely to rupture due to hail impact.

Applicant's claim 18 also recites *inter alia*,

"a primary waterproofing membrane disposed over at least a substantial portion of said roof deck."

Kelly does not teach a primary waterproofing membrane disposed over at least a substantial portion of said roof deck. The Examiner equates the primary water proofing layer of Applicant's claim 18 with "the layer directly above the deck layer" (see page 2 of the Office Action) in Figure 31 of Kelly. However, referring to column 11 lines 7-9, Kelly teaches this layer to be an insulation layer included in the built up roof (BUR) 108. Applicant respectfully

submits that it is well known in the art that an insulation layer would not function as a waterproofing layer, as it typically consists of such non-waterproofing materials as gypsum, fiberboard, and wood (see column 5 line 54 of Kelly). Applicant points to Kelly's inclusion of an actual waterproofing membrane 9 as further evidence that the insulation layers 14 (and the insulation layer of 108) of Kelly are not taught for waterproofing purposes.

For at least the reasons set forth above, Applicant respectfully asserts that Kelly does not teach every element of Applicant's claim 18, or claims 19 and 20 that depend therefrom. Accordingly, Applicant respectfully submits that Kelly does not anticipate claims 18-20.

#### Claim Rejections Under 35 U.S.C. §103

Claims 1-2, 6, 9-17, and 22-30 have also been rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly, and Kelly in view of United States Patent No. 5,560,150 to Pearson ("Pearson" hereinafter).

Applicant's claim 1 recites *inter alia*:

"a waterproof membrane loose laid over said frangible energy absorbing layer."

Kelly does not teach a waterproof membrane loose laid over said frangible energy absorbing layer. Instead, referring to column 9 lines 24-26, Kelly teaches that a screw 20 is "mounted in termination bar 18 and driven through all of the layers of the existing roof deck to secure the entire assembly." As is clearly shown in Figure 31 of Kelly, the screw 20 is disposed through the membrane 9 and into the layers below so as to mechanically secure the membrane 9 to the layers below the membrane 9. Thus, Kelly teaches a mechanical securing of membrane 9 to the layers below membrane 9 as opposed to the *loose laid* membrane recited in Applicant's claim 18. Applicant respectfully notes that a loose laying of the membrane is important to hail resistance in that a taught membrane is more likely to rupture due to hail impact.

For at least this reason, Applicant respectfully asserts that Kelly does not teach every element of Applicant's claim 1, or claims 2, 6, 9-16, and 22-30 that depend therefrom. Accordingly, Applicant respectfully submits that claims 1-2, 6, 9-16, and 22-30 are not obvious over Kelly.

Referring to claim 17, Applicant recites

“a layer of stiff material attached to said roof deck; [and] a primary waterproofing membrane supported by said stiff material.”

Kelly does not teach a layer of stiff material attached to a roof deck or a primary waterproofing membrane supported by this stiff material. First Applicant points out that the layer 110, which the Examiner equates with Applicant’s “layer of stiff material,” is taught in Kelly as a gravel layer 110. In Kelly, this gravel 110 is not taught to be “attached” to anything, but is instead taught to be disposed between layers of insulation 14. As shown in Figure 31, the gravel 110 does not contact the deck 12 (insulation of the BUR 108 being disposed between the deck 12 and the gravel 110), and thus, the gravel layer 110 is not “attached” to the deck 12. Applicant respectfully points out that the gravel 110, due to its nature, could not be “attached” to the deck 12 via the mechanical fastener 20.”

Referring to “the primary waterproofing layer supported by the stiff material,” the Examiner equates this layer of Applicant’s claim 17 with “the layer 14 directly above layer 10” (see page 3 of the Office Action) in Figure 31 of Kelly. However, referring to column 11 lines 7-9, Kelly teaches this layer to be an insulation layer included in the built up roof (BUR) 108. Applicant respectfully submits that it is well known in the art that an insulation layer would not function as a waterproofing layer, as it typically consists of such non-waterproofing materials as gypsum, fiberboard, and wood (see column 5 line 54 of Kelly). Applicant points to Kelly’s inclusion of an actual waterproofing membrane 9 as further evidence that the insulation layers 14 (and the insulation layer of 108) of Kelly are not taught for waterproofing purposes.

For at least this reason, Applicant respectfully asserts that Kelly does not teach every element of Applicant’s claim 17. Accordingly, Applicant respectfully submits that claim 17 is not obvious over Kelly.

Referring now to Pearson, as Pearson does not remedy the above-discussed deficiencies of Kelly, Applicant respectfully submits that claims 1-2, 6, 9-17, and 22-30 are not obvious over the proposed combination of Kelly and Pearson.

Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly, and Kelly in view of United States Patent No. 5,560,150 to Pearson (“Pearson” hereinafter).

As claim 3 depends from claim 1, for at least the reasons discussed in overcoming the rejection of claim 1, Applicant respectfully submits claim 3 is not obvious over Kelly, or the proposed combination of Kelly and Pearson.

Claims 4-5 have been rejected over Kelly in view of United States Patent No. 6,250,036 to Nurley (“Nurley” hereinafter), and Kelly in view of Nurley, in view of Pearson.

As claims 4 and 5 depend from claim 1, and as neither Nurley nor Pearson remedy the above-discussed deficiencies of Kelly as they relate to claim 1, Applicant respectfully submits that claims 4 and 5 are not obvious over the proposed combination of Kelly and Nurley, and Kelly, Nurley and Pearson.

Claims 7-8 have been rejected over Kelly in view of United States Patent No. 6,006,482 to Bennett (“Bennett” hereinafter), and Kelly in view of Bennett, in view of Pearson.

As claims 7 and 8 depend from claim 1, and as neither Bennett nor Pearson remedy the above-discussed deficiencies of Kelly as they relate to claim 1, Applicant respectfully submits that claims 7 and 8 are not obvious over the proposed combination of Kelly and Bennett, and Kelly, Bennett and Pearson.

Claim 21 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Bennett.

As claim 21 depends from claim 18, for at least the reasons discussed in overcoming the rejection of claim 18, Applicant respectfully submits claim 3 is not obvious over the proposed combination of Kelly and Bennett.

Claim 31 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Pearson and Bennett.

Similarly to claims 1 and 18, claim 31 recites, *inter alia*,

“a loose laid, non-reinforced waterproofing membrane with fabricated wrinkles disposed upon said gypsum board.”

Kelly does not teach a loose laid, non-reinforced waterproofing membrane with fabricated wrinkles disposed upon said gypsum board. Instead, referring to column 9 lines 24-26, Kelly teaches that a screw 20 is “mounted in termination bar 18 and driven through all of the layers of the existing roof deck to secure the entire assembly.” As is clearly shown in Figure 31 of Kelly, the screw 20 is disposed through the membrane 9 and into the layers below so as to mechanically secure the membrane 9 to the layers below the membrane 9. Thus, Kelly teaches a mechanical securing of membrane 9 to the layers below membrane 9 as opposed to the *loose laid* membrane recited in Applicant’s claim 18. Applicant respectfully notes that a loose laying of the membrane is important to hail resistance in that a taught membrane is more likely to rupture due to hail impact.

Accordingly, Applicant respectfully submits claim 31 is not obvious over Kelly.

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant’s attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

Applicant hereby petitions for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,  
Cantor Colburn LLP

By: \_\_\_\_\_

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